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Supreme Court, U.S.
FILED

No. 991793 MAR 13 2000

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In the Supreme Court of the United States

JULIE A. BOWEN AND BARBARA J. MARTY,
PETITIONERS,

v.

BOARD OF PATENT APPEALS AND INTERFERENCES,
RESPONDENT.

ON PETITION FOR WRIT OF CERTIORARI FOR THE DECEMBER 13, 1999 DECISION OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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Blanchard Press, Inc., Boston, Mass — Law Printers (617) 426-6690

46 pp

QUESTIONS PRESENTED

I. Has the Federal Circuit Erred By Issuing A Rule 36 Affirmance Without Opinion For A Question Of Law Requiring a *De Novo* Review Due To A Misinterpretation of *Dickinson v. Zurko*?

II. Has the Federal Circuit Erred By Allowing the PTO To Avoid It's Statutory Burden To Respond To Applicant's Declaration?

III. Has the Federal Circuit Erred By Not Adhering to Legislative Intent To Create Clear and Uniform Patent Law?

TABLE OF CONTENTS

Table Of Cited Authorities	iii
Citations Of Opinions and Orders	vii
Statement of Jurisdiction	viii
Statutes	viii
Statement Of The Case	1
Argument	2
I. The Federal Circuit Erred In Issuing A Rule 36 Affirmance Without Opinion In Violation of *Dickinson v. Zurko* In Interpreting The Administrative Procedures Act	4
II. The Federal Circuit Erred By Permitting The PTO Appeals Board Ruling To Stand When the PTO Had Not Fulfilled Its Burden.	13
III. The Federal Circuit Erred In Not Meeting The Legislative Intent of The Federal Court Improvement Act of 1982	16

TABLE OF CITED AUTHORITIES

Cases

ACS Hosp. Sys., Inc. v. Montefiore Hosp. 6
732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984)

Citizens to Preserve Overton Park, Inc. v. Volpe 7
401 U.S. 402, 91 S. Ct. 814, 28 L. Ed.2d 136, 2 ERC 1250, 1 Envtl. L. Rep. 20,110 (U.S. Tenn. 1971)

Commissioner of Internal Revenue v. McCoy 11
484 U.S. 3, 108, S. Ct. 217 (1987)

County of Los Angeles et. al. v. Kling 11
474 U.S. 936, 106 S. Ct. 300 (1985)

Daff v. U.S. 9
78 F.3d 1566, 40 Cont. Cas. Fed. (CCH) P 76,899, *rehearing denied, in banc suggestion denied* (Fed. Cir. 1996)

Dickinson v. Zurko 7, 10, 15
527 U.S. 150, 119 S. Ct. 1816, 144 L. Ed.2d 143, USLW 3683, 67 USLW 3683, 67 USLW 4445, 50 U.S.P.Q.2d 1930, 99 Cal. Daily Op. Serv.4504, 1999 Daily Journal D.A.R. 5792, 1999 CJ C.A.R. 3216, 12 Fla. L. Weekly Fed. S 310 (U.S. 1999)

Diocese of Winona v. Interstate Fire & Cas. Co. 9
89 F.3d 1386, *rehearing denied* (8th Cir. (Minn.) 1996)

Enron Oil Trading & Trans. Co. v. Walbrook Ins. Co., Ltd. 9
132 F.3d 526, 40 Fed. R. Serv.3d 233, 28 Envtl. L. Rep. 20,448, 97 Cal. Daily Op. Serv. 9608, 97 Daily Journal D.A.R. 15,387 (9th Cir. (Mont.) 1997)

Gardner v. Tec Sys. Inc. 8
725 F.2d 1338, 1344 (Fed. Cir. 1984), *cert denied,*
469 U.S. 830 (1984)

Golden v. Kelsey-Hayes Co. 9
73 F.3d 648, 64 USLW 2458, 151 L.R.R.M.
(BNA) 2258, 19 Employee Benefits Cas. 2457, 1996 Fed. App.
21P, Pens Plan Guide (CCH) P 23923V (6th Cir. (Mich.) 1996)
cert. denied 519 U.S. 807, 117 S. Ct. 49, 136 L. Ed. 2d 13,
65 USLW 3256, 20 Employee Benefits Cas. 1872 (1996)

Graham v. John Deere Co. of Kansas City 8
383 U.S. 1, 86 S. Ct. 684, 15 L. Ed.2d 545,
148 U.S.P.Q. 459 (U.S. (Mo.) 1966)

H.B. Mac. Inc., v. U.S. 9
153 F.3d 1338, 98 Cont. Cas. Fed. (CCH) P 77,357
(Fed. Cir. 1998)

Heidelberg Harris, Inc. v. Loebach 9
145 F.3d 1454, 46 U.S.P.Q.2d 1948, *rehearing denied*
(Fed. Cir. (N.H.) 1998)

In re Andersen 10
743 F.2d 1578, 223 U.S.P.Q. 378 (Fed. Cir. 1984),
cert. denied 471 U.S. 1015, 105 S. Ct. 2019, 85 L. Ed.2d
301 (1985)

In re Carleton 10
599 F.2d 1021, 202 U.S.P.Q. 165 (CCPA 1979)

In re De Blauwe 10
736 F. 2d 699, 222 U.S.P.Q. 191 (Fed. Cir. 1984)

In re Dembiczak 14
175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999),
*abrogated by In re Gartside,*2000, WL 156565 (Fed. Cir. 2000)

In re Gartside 7
2000, WL 156565 (Fed. Cir. 2000)

In re Kemps 8
97 F.3d 1427, 40 U.S.P.Q. 2d 1309 (Fed. Cir. 1996),
abrogated by In re Gartside, 2000, WL 156565 (Fed. Cir. 2000)

In re McCarthy 10
763 F.2d 411, 226 U.S.P.Q. 99 (Fed. Cir. 1985)

In re Vaeck 8
947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)

In re Warner 10
379 F.2d 1011, 154 U.S.P.Q. 173, 54 C.C.P.A. 1628
(CCPA 1967) *cert. denied*, 389 U.S. 1057, 88 S. Ct. 811,
19 L. Ed. 2d 857, *rehearing denied* 390 U.S. 1000, 88 S. Ct.
1201, 20 L. Ed.2d 101 (1968)

Interconnect Planning Corp. v. Feil 14
774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir (N.Y.) 1985)

Krygoski Const. Co., Inc. v. U.S. 9
94 F.3d 1537, 41 Cont. Cas. Fed. (CCH) P 76,985,
rehearing denied (Fed. Cir. 1996)

Lubbock County Hosp. Dist., v. Nat'l Union Fire Ins. Co 8
of Pittsburg Penn 143 F.3d 239, 28 Envtl. L. Rep. 21,424,
rehearing denied (5th Cir. (Tex.) 1998)

Monroe Auto Equipment. Co. v. Heckethorn 8
Mfg. & Supply Co 332 F. 2d 406, 141 U.S.P.Q. 549, *cert.*
denied, 379 U.S. 888, 85 S. Ct. 160, 13 L. Ed.2d 93, 143
U.S.P.Q. 465 (6th Cir. (Tenn.) 1964)

Montana v. Hall 11
481 U.S. 400, 107 S. Ct. 1825, 95 L. Ed. 2d 354 (1987)

Moore v. Penn. Castle Energy Corp. 9
89 F.3d 791, 134 Oil & Gas Rep. 1 (11th Cir. (Ala.) 1996)

Panduit Corp. v. Dennison Mfg. Co. 8
810 F.2d 1561, 1 U.S.P.Q. 2d 1593 (Fed. Cir. (Ill.) 1987)
cert. denied 481 U.S. 1052, 107 S. Ct. 2187, 95 L. Ed.2d 843 (1987)

Skidmore v. Swift 4
323 U.S. 134, 65 S. Ct. 1256, 89 L. Ed. 124 (U.S. (Tex.) 1944)

U.S. ex rel. Modern Elec. v. Ideal Electronic Sec. Co., Inc. 9
81 F.3d 240, 317 U.S. App. D.C. 145, 35 Fed. R. Serv.3d 118, 40 Cont. Cas. Fed. (CCH) P 76,918 (D.C. Cir. 1996)

Viam Corp. v. Iowa Export-Import Trading Co. 9
84 F.3d 424, 38 U.S.P.Q.2d 1833 (Fed. Cir. (Cal.) 1996)

Volkman v. United Transp. Union 9
73 F.3d 1047, 151 L.R.R.M. (BNA) 2452 (10th Cir. 1996)

Law Reviews

Kelly Ann Casey 2
Exxon Chemical Patents, Inc. v. Lubrizol Corp.: The Federal Circuit Sets Unreasonable Standards For Chemical Composition Inventions. 31 Ga. L. Rev. 1223, fn 4 (Summer 1997)

Congressional Record Citations

126 Cong. Rec. H25364 (daily ed. Sept. 15, 1980)	17
126 Cong. Rec. H25366 (daily ed. Sept. 15, 1980)	17
126 Cong. Rec. S28106 (daily ed. Sept. 30, 1980)	5
127 Cong. Rec. S29858 (daily ed. Dec. 08, 1981)	18
127 Cong. Rec. S29861 (daily ed. Dec. 08, 1981)	18
127 Cong. Rec. S29887 (daily ed. Dec. 08, 1981)	17
127 Cong. Rec. S29888 (daily ed. Dec. 08, 1981)	19

CITATION OF OPINIONS AND ORDERS

Patent and Trademark Office - Examiner Final Office Action (3/14/97) 08/758,756 denial based on nonobviousness and anticipation

Patent and Trademark Office - Opinion of Board of Patent and Interferences (12/04/98) - Examiner Affirmance of nonobviousness but overturned anticipation.

Federal Circuit - Rule 36 - Judgement of Affirmance Without Opinion; Notice of Entry Dec. 13, 1999 (*In re Bowen* 99-1260)

STATEMENT OF JURISDICTION

As a federal issue arising in the Federal Circuit as of December 13, 1999, the constitutional jurisdiction of the Supreme Court is premised on 28 U.S.C.§1295.

STATUTES

5 U.S.C. §706 (The Administrative Procedures Act) 7, 8

Scope of Review

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall ---

(1) compel agency action unlawfully withheld or unreasonably delayed; and

(2) hold unlawful and set aside agency action, findings, and conclusions found to be --

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power, privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by the reviewing court.

(F) unwarranted by the facts to the extent that the facts are subject to trial *de novo* by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

28 U.S.C. §131 - Rules of Courts 6

Section 2071. Rule-making power generally

Such rules shall be consistent with Acts of Congress ...

Section 2072. Rules of procedure and evidence; power to prescribe

The Supreme Court shall have the power to prescribe general rules of practice and procedure ...

35 U.S.C. §103 8, 11, 13

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

STATEMENT OF THE CASE

This appeal is based on a decision of the Court of Appeals for the Federal Circuit on Dec. 13, 1999 (*see* Appendix) whose jurisdiction over the Patent and Trademark Office is based on 35 U.S.C. §141.

The issues of this case reflect a lack of adherence by both the Patent and Trademark Office (PTO) and the Federal Circuit to this Court's precedents involving patentability standards of review and elements required to show obviousness. The substantive aspect of this appeal deals with the lack of adequate evidence to support a 35 U.S.C. §103 patentability rejection. The Federal Circuit upheld this obviousness rejection of the Patent and Trademark Office on the basis of a single non-anticipating piece of prior art; the only other evidence in the record was a declaration from one of the inventors which rebutted the allegations of the PTO. Since there was no other evidence offered by the PTO, there was nothing to bridge the gap between the cited art (which was non-anticipating and thus lacked, by definition, all of the elements claimed) and the claimed invention. Simply put: the PTO did not satisfy its burden. And yet, the Federal Circuit upheld the PTO *without any reasoning or opinion!*

A Rule 36 Affirmance Without Opinion was delivered despite the expression of clear judicial surprise and condemnation of the PTO's position at oral argument due to the lack of sufficient evidence presented by the PTO in defense of their rejection. Therefore, it is submitted that the Federal Circuit has erroneously applied a deferential review, based on *Dickinson v. Zurko*, to this question of law by not applying a *de novo* review as required by the Administrative Procedures Act and mandatory case law precedent of this Court.

The Federal Circuit erred by not remanding the patent prosecution to the Patent and Trademark Office after discovering that the PTO's burden of responding to the appellant's declaration (or otherwise offering up some kind of evidence) was not satisfied. J. Markey specifically noted this irresponsibility during oral argument.

J. Newman opined at oral argument that avoidance of this error would have likely resulted in the issuance of the appellants application (the statements made by the reviewing judges were preserved because of the routine taping of oral argument by the Federal Circuit; some of these statements are set forth below and discussed in more detail).

Finally, the Federal Circuit erred by not fulfilling its congressionally mandated legislative intent to clarify and unify patent law. This required purpose cannot be met without fully reasoned and published opinions.

For the Federal Circuit to implement Rule 36 it is required that the decision have no precedential value. The appellant argues that a 35 U.S.C. §103 rejection -- which is the battleground for inventors and patent practioners before the PTO -- which was based merely on a single piece of prior art and the "subjective opinion of the PTO" is not a PTO ruling that can be properly handled with a Rule 36 decision. The decision is contrary to previous Federal Circuit decisions that requires obviousness to have a combination of prior art and a motivation to combine the prior art. Therefore, for the Federal Circuit to allow an obviousness rejection to stand on a single piece of prior art -- without any additional evidence -- is contrary to the law of the Patent Act.

ARGUMENT

In general, this Court rarely grants petitions for writ of certiorari to the United States Court of Appeals for the Federal Circuit. "Because the Supreme Court rarely reviews patent cases, . . . , the Federal Circuit is functionally the highest court in the United States for patent matters." Kelly Ann Casey, *Exxon Chemical Patents, Inc. v. Lubrizol Corp.: The Federal Circuit Sets Unreasonable Standards For Chemical Composition Inventions*. 31 Ga. L. Rev. 1223, fn 4 (Summer 1997)(citing The U.S. Judicial Conference Comm. on the Bicentennial of the Constitution of the U.S., *The United States Court of Appeals for the Federal Circuit: A History*, 1982-1990 at 227). While the Supreme Court reviews

conflicts between the other circuit courts, there is no such potential for the Federal Circuit. The Federal Circuit decisions stand alone -- without the benefit of comment from other circuit judges. This unique situation should, it is repectfully submitted, cause the Supreme Court to review Federal Circuit decisions *more* frequently -- not less frequently. The Supreme Court is the only potential player to check and balance the Federal Circuit decisions.

The present case is of general importance to inventors and the patent bar. The present case raises the critical questions: 1) does the PTO have the burden to support an obviousness rejection with clear evidence in the record, and 2) can the Federal Circuit affirm without opinion when the PTO has not provided clear evidence in the record. These issues will continue to face inventors in the future. Given the importance of technology and the patent system to the welfare of the people of the United States, the statutory patentability requirement of nonobviousness (35 U.S.C. §103) and the related appropriate standard of review of the Patent and Trademark Office for "questions of law" within 5 U.S.C. §706 requires clarification by the highest court in the land.

When sustaining a 35 U.S.C. §103 rejection, a Court of Appeals for the Federal Circuit (CAFC) Rule 36-Judgment of Affirmance Without Opinion lacks the appropriate and required standard of review, guidance, or analysis for both the legal community and inventors. In the present case, the CAFC has failed to demonstrate proper procedures to; 1) review a Patent and Trademark Office (PTO) final 35 U.S.C. §103 patent rejection *de novo*, 2) explain the merits of a clear "constructive reversal" resulting from disparate opinions voiced at oral argument and the final affirmance decision, 3) explain why it is appropriate, and non-precedential, to sustain a 35 U.S.C. §103 patent rejection based on a single piece of non-anticipatory prior art, and 4) implement the legislative intent surrounding CAFC's creation to improve patent law clarity and uniformity.

We argue that the CAFC's affirmance in this case is contrary to 35 U.S.C. §103 and interpretative common law precedents. An

expressed legal analysis is especially critical, as in the instant case, when the CAFC judicial oral argument opinions are substantively contrary to the final judgement. We argue that the CAFC Rule 36 is contrary to statutory interpretive case law regarding judicial review standards for patent nonobviousness and the legislative intent of CAFC formation. With regard to legislative intent, it is important to stress that the Federal Circuit was created in 1982 under unique circumstances. As explained more fully below, while other courts may be permitted to render decisions without opinion, the Federal Circuit was created to give *clarity* to standards of patentability. As such, we submit to the Court that Rule 36 decisions to not further this legislative intent. At the very least, Rule 36 decisions should not be permitted where the Federal Circuit is ruling on the respective burdens of the inventor and PTO in the context of an obviousness rejection. Rulings of this type are too central to the Federal Circuit's purpose. As a result, the appellant respectfully requests consideration that this Court vacate and remand the judgement below in accordance with the following legal analysis.

I. The Federal Circuit Erred In Issuing A Rule 36 Affirmance Without Opinion In Violation of *Dickinson v. Zurko* In Interpreting The Administrative Procedures Act.

Congressional legislative intent clearly mandates CAFC decisions to improve the clarity of the patent law (*infra*). Clarity of the law requires the expression and articulation of the law. In the instant case, CAFC Rule 36 results in an entry of judgment without a clear expression of the law. This is in stark contrast to established precedent by this Court that judicial interpretation of government agency decisions requires an in-depth assessment. *See, Skidmore v. Swift*, 323 U.S. 134, 65 S. Ct. 1256, 89 L. Ed. 124 (U.S. (Tex.) 1944). During the congressional floor debates concerning the Federal Court Improvement Act of 1982, Senator Bumpers introduced Amendment 1701; "An amendment to improve the administrative process by making Federal agencies more responsive to the will of the people as expressed by their elected representatives of Congress". Senator Bumpers cited *Skidmore* in his advocacy

presentation within the following context:

> "The effect of any agency interpretative judgment, whether contained in a rule or order, on the court's own interpretation should not, however, depend on some general rule or deference. Rather the court, in examining the agency interpretation, should evaluate "the thoroughness in its consideration, the validity of its reasoning, its consistency with earlier and later pronouncements, and all these factors which give it power to persuade if lacking power to control." *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944). The court should also weigh any countervailing factors bearing on the validity of the agency's legal position.
>
> Thus, the court may not regard the agency's reading of the statute as controlling or entitled to a deference that would avoid the court's reaching its own independent judgment. Accordingly, under this amendment, a reviewing court may not proceed on the assumption that it should uphold an agency's statutory construction so long as that construction is "not unreasonable" or "not irrational". Instead, the court shall regard the interpretation of the statute as a judicial question."

126 Cong. Rec. S28106 (daily ed. 09/30/1980)(statement of Sen. Bumpers)

CAFC Rule 36 cannot provide a thoroughly considered assessment, establish the validity of the PTO's reasoning, or compare consistency with any earlier or later pronouncements. More importantly, a CAFC Rule 36 cannot express any weighed "countervailing factors" in determining the validity of the PTO's legal position. When, as here, facts and judicial opinions expressed at oral argument are contrary to the final decision, adherence to the above elements of analysis are congressionally mandated.

The Constraints On The Federal Circuit

The CAFC has exclusive statutory authority over all patent appeals whether they arise from PTO appeals or from district courts hearing civil infringement litigation. Federal Courts Improvement Act of 1982, Pub. L. 97-164, §402, 96 Stat. 25, 57 (codified at 28 U.S.C. §1295 (1988), 35 U.S.C. §§141 - 146 (1988)). However, as a congressionally created court, the CAFC is constrained to operate within the spirit of the congressional intent. Moreover, the Federal Circuit rules aregoverned by 28 U.S.C. §131 - Rules of Courts;

> Section 2071. Rule-making power generally
>
> Such rules shall be consistent with Acts of Congress ...
>
> Section 2072. Rules of procedure and evidence; power to prescribe
>
> (a) The Supreme Court shall have the power to prescribe general rules of practice and procedure ...

In the present case, the CAFC has ruled without an opinion, implying that the instant case has no precedential value. This is clearly not the case. The CAFC does not have an established method or interpretation of 35 U.S.C. §103 nonobviousness rejections based on a single piece of prior art. The vast majority of PTO obviousness rejections involve tenuous relationships between numerous prior art citations. In fact, this Court, and the CAFC, are aware that the vast majority of PTO appeals involve inappropriate patent rejections based on Examiner creativity providing imaginary relationships between unrelated prior art. The CAFC has rightly attempted to correct this practice. *See*, *ACS Hosp. Sys., Inc. v. Montefiore Hosp.* 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). However, the treatment of an obviousness rejection involving a single piece of prior art and the "subjective opinion of the PTO" that the invention was "known to one with ordinary skill in the art at the time of invention" has no line of cases to follow. Therefore, the CAFC has

essentially "buried" this issue under the guise of "...an opinion [that] would have no precedential value." when it is a case of opposite nature. We submit that this case requires revelation and full explanation.

Standard of Review

The PTO, like all other government agencies, is subject to the Administrative Procedures Act (APA) codified as 5 U.S.C. §§500-706. *See, Dickinson v. Zurko,* 527 U.S. 150, 119 S. Ct. 1816, 144 L. Ed.2d 143, USLW 3683, 67 USLW 3683, 67 USLW 4445, 50 U.S.P.Q.2d 1930, 99 Cal. Daily Op. Serv. 4504, 1999 Daily Journal D.A.R. 5792, 1999 CJ C.A.R. 3216, 12 Fla. L. Weekly Fed. S 310 (U.S. 1999). As discussed below, §706 provides the appropriate scope(s) of review that are available for judicial review of agency decisions. The appellant submits that the instant case requires application of §706(2)(F) for a *de novo* review. This section requires a court to hold agency actions unlawful when they are "unwarranted by the facts" following an agency adjudicative action. "... such *de novo* review is authorized when the action is adjudicatory in nature and the agency factfinding procedures are inadequate." *Citizens to Preserve Overton Park, Inc. v. Volpe*, 401 U.S. 402, 91 S. Ct. 814, 28 L. Ed.2d 136, 2 ERC 1250, 1 Envtl. L. Rep. 20,110 (U.S. Tenn. 1971). Although not binding on the present case, the appellants take note of the CAFC's recent analysis of the standards of review for obviousness. *See, In re Gartside*, 2000 WL 156565, No. 99-1241, (Fed. Cir. 2000)(holding that factual determinations made in support of patentability rejections for obviousness are reviewed under a substantial evidence standard according to 5 U.S.C. §706(E)). This holding provides a legal standard imbalance that preempts *de novo* consideration of obviousness as "a question of law" because it is dependent on a more deferential "substantial evidence" standard. Under the appellants present understanding of this case, the obviousness analysis process requires review of the underlying facts by the *Gartside* standards before obviousness as "an issue of law" comes within reach of the court. Subsequently, a review that finds facts "substantiated by the evidence" implies that the "factfinding

procedures" are adequate. This conflict completely avoids application of the proper standard of review for "adequate factfinding procedures" mandated in 5 U.S.C. §706(2)(F). The appellants submit that the CAFC inappropriately considered the *Gartside* decision when issuing the present Rule 36 decision.

The present decision supporting a 35 U.S.C. §103 rejection with a single piece of non-anticipatory prior art and the "subjective opinion of the PTO" represents inadequate factfinding procedures. The CAFC affirmance is inappropriately deferential to the agency and ignores; 1) the APA, 2) the CAFC's enacting legislative intent (*infra*), and 3) *stare decisis* to CAFC mandatory case law.

Mandatory CAFC case law demands *de novo* review of all 35 U.S.C. §103 rejections even where obviousness is a legal conclusion based on factual evidence. *See, Graham v. John Deere Co. of Kansas City* 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed.2d 545, 148 U.S.P.Q. 459 (U.S. (Mo.) 1966) *(citing Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (6th Cir. 1964), *cert. denied* 379 U.S. 888, 85 S. Ct. 160, 13 L. Ed. 2d 93); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 U.S.P.Q. 2d 1593 (Fed. Cir. (Ill.) 1987)("Obviousness is a legal question based on underlying factual determinations."), *cert. denied*, 481 U.S. 1052, 107 S. Ct. 2187, 95 L. Ed.2d 843 (1987); *Gardner v. Tec Sys. Inc.*, 725 F.2d 1338, 1344 (Fed. Cir. 1984), *cert denied,* 469 U.S. 830 (1984)("A conclusion on obviousness is one of law and subject to full and independent review in this court), *cert denied,* 469 U.S. 830 (1984); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)("Obviousness is a legal question which this court independently reviews..."); *and In re Kemps*, 97 F.3d 1427, 40 U.S.P.Q. 2d 1309 (Fed. Cir. 1996)("We review the ultimate determination of obviousness *de novo...*"), *abrogated by In re Gartside,* 2000 WL 156565 (Fed. Cir. 2000).

The several circuits uniformly apply a *de novo* analysis to questions of law. *See, Lubbock County Hosp. Dist., v. Nat'l Union Fire Ins. Co. of Pittsburgh Penn,* 143 F.3d 239, 28 Envtl. L. Rep.

21,424, *rehearing denied* (5th Cir. (Tex.) 1998); *Golden v. Kelsey-Hayes Co.*, 73 F.3d 648, 64 USLW 2458, 151 L.R.R.M. (BNA) 2258, 19 Employee Benefits Cas. 2457, 1996 Fed. App. 21P, Pens Plan Guide (CCH) P 23923V (6th Cir. (Mich.) 1996) *cert. denied* 519 U.S. 807, 117 S. Ct. 49, 136 L. Ed. 2d 13, 65 USLW 3256, 20 Employee Benefits Cas. 1872 (1996); *Diocese of Winona v. Interstate Fire & Cas. Co.*, 89 F.3d 1386, *rehearing denied* (8th Cir. (Minn.) 1996); *Enron Oil Trading & Trans. Co. v. Walbrook Ins. Co., Ltd.*, 132 F.3d 526, 40 Fed. R. Serv.3d 233, 28 Envtl. L. Rep. 20,448, 97 Cal. Daily Op. Serv. 9608, 97 Daily Journal D.A.R. 15,387 (9th Cir. (Mont.) 1997); *Volkman v. United Transp. Union*, 73 F.3d 1047, 151 L.R.R.M. (BNA) 2452 (10th Cir. 1996); *and Moore v. Penn. Castle Energy Corp.*, 89 F.3d 791, 134 Oil & Gas Rep. 1 (11th Cir. (Ala.) 1996).

More significantly, the CAFC has routinely applied *de novo* review to non-patentability questions of law. *See, H.B. Mac. Inc., v. U.S.*, 153 F.3d 1338, 98 Cont. Cas. Fed. (CCH) P 77,357 (Fed. Cir. 1998)(reviewing legal conclusions *de novo* arising from court of Federal Claims); *Krygoski Const. Co., Inc. v. U.S.*, 94 F.3d 1537, 41 Cont. Cas. Fed. (CCH) P 76,985 *rehearing denied* (Fed. Cir. 1996)(reviewing error of law *de novo* arising from court of Federal Claims); *Viam Corp. v. Iowa Export-Import Trading Co.*, 84 F.3d 424, 38 U.S.P.Q.2d 1833 (Fed. Cir. (Cal.) 1996); *U.S. ex rel. Modern Elec. v. Ideal Electronic Sec. Co., Inc.*, 81 F.3d 240, 317 U.S. App. D.C. 145, 35 Fed. R. Serv.3d 118, 40 Cont. Cas. Fed. (CCH) P 76,918 (D.C. Cir. 1996)(reviewing conclusions of law *de novo*); *Heidelberg Harris, Inc. v. Loebach*, 145 F.3d 1454, 46 U.S.P.Q.2d 1948, *rehearing denied* (Fed. Cir. (N.H.) 1998)(construing a patent license contract as a matter of law reviewable *de novo*); and *Daff v. U.S.*, 78 F.3d 1566, 40 Cont. Cas. Fed. (CCH) P 76,899, *rehearing denied, in banc suggestion denied* (Fed. Cir. 1996)(reviewing *de novo* a contract interpretation as a matter of law).

The most relevant holding for this case concerning the appropriate standard of review for obviousness rejections is as follows:

> Obviousness is a conclusion of law. It is our responsibility, as for all appellate courts, to apply the law correctly; **without deference to Board determinations**, which may be in error even if there is a rational basis therefor. This principle controlled our predecessor court, see, *e.g.*, *In re Carleton*, 599 F.2d 1021, 1024 n. 14, 202 USPQ 165, 168-169 n. 14 (CCPA 1979); *In re Warner*, 379 F.2d 1011, 1016 n. 6, 154 USPQ 173, 177 n. 6 (CCPA 1967) (obviousness is a legal conclusion), *cert. denied*, 389 U.S. 1057, 88 S. Ct. 811, 19 L. Ed. 2d 857 (1968); and continues in this court. see, *e.g.*, *In re Andersen*, 743 F. 2d 1578, 1580, 223 USPQ 378, 380 (Fed. Cir. 1984); *In re De Blauwe*, 736 F. 2d 699, 703, 222 USPQ 191, 195 (Fed. Cir. 1984) ("we caution the Solicitor that obviousness is a question of law").

In re McCarthy, 763 F.2d 411, 226 U.S.P.Q. 99 (Fed. Cir. 1985) [emphasis added]

Therefore, *In re McCarthy* clearly sets CAFC precedent that all §103 rejections are reviewed as questions of law without PTO deference. Here, neither of these "rules" are followed. Apparently, the CAFC did not review the PTO's decision *de novo*. Second, when compared to contrary oral argument judicial opinions (*infra*), the ruling is totally and unjustifiably deferential to the PTO's initial examination.

The CAFC PTO deference is an improper reaction to the recent holding of *Zurko* (*supra*). *Zurko* does not reach questions of law and subsequent requirements for *de novo* review. The holding of *Zurko* is directed at questions of fact that CAFC precedents reviewed as "clearly erroneous". This Court now requires the CAFC

to use the more deferential APA standard of "arbitrary and capricious, or abuse of discretion" to resolve patentability questions involving questions of fact. Patent rejections under 35 U.S.C. §103 are questions of law, therefore *Zurko* is not applicable. As such, a CAFC Rule 36 silence surrounding a decision on a question of law requiring a *de novo* standard of review in the face of contrary oral argument judicial opinions is inappropriate and irresponsible.

De novo review begs a full written opinion. Members of this Court have expressed disfavor for summary dispositions. *See, Commissioner of Internal Revenue v. McCoy*, 484 U.S. 3, 108 S. Ct. 217 (1987)(Marshall, J. dissenting: stating that without review of the full record, summary disposition is contrary to the legitimate expectations of the parties -- whereas a thorough review leads to a greater accuracy in decision making); *and Montana v. Hall*, 481 U.S. 400, 405, fn 1 & fn 2, 107 S. Ct. 1825, 1827-1828, fn 1 & fn 2, 95 L. Ed. 2d 354 (1987); *see also County of Los Angeles et. al. v. Kling*, 474 U.S. 936, 106 S. Ct. 300 (1985) (Marshall, J. dissenting: stating that a decision not to publish the opinion or permit it to be cited - like the decision to promulgate a rule spawning a body of secret law -- was plainly wrong). Therefore, the CAFC erred in not explaining to the appellant why the final decision was contrary to the opinions expressed at oral argument.

We argue, at a minimum, that this unexplained implementation of CAFC Rule 36 is in error relative to patentability review standards. It is simply an improper expediting of the judicial calendar is contrary to the best interests of the public, patent law and the related business community.

The CAFC is under congressional charge to provide clear and uniform guidance in patent law. This guidance is especially critical in the currently unclear application of 35 U.S.C. §103 by the PTO in regards to invention obviousness. We submit that *de novo* is the appropriate scope of review analysis and the circumstances of the instant issue forces the CAFC to openly discuss their opinion. Most important is the clear precedential value of the current case. This

case provides the situation in which the PTO based a 35 U.S.C. §103 obviousness rejection on a single piece of non-anticipating prior art combined with the "subjective opinion of the PTO". A clear position from the CAFC on the deference (or lack theeof) to the PTO under these circumstances is of crucial importance to the entire patent bar and all present and potential inventors. To relegate this "precedent" to the abyss of "secret law" is counterproductive and chills the atmosphere for continued innovation and protection of intellectual property.

II. The Federal Circuit Erred By Permitting The PTO Appeals Board Ruling To Stand When the PTO Had Not Fulfilled Its Burden.

The requirements for a patentable invention is governed by 35 U.S.C.. In this case, the appellant received final rejection based on §103 indicating that the invention was obvious to one skilled in the art at the time of the invention. This obviousness rejection is based on a single piece of prior art (Griffin: Reusable Stationary Container, US 4,790,475: see Appendix) that the PTO argued presented an adequate introduction of the invention to the art despite its failure to sustain a §102 rejection. During oral argument two members of the CAFC panel (Mayer and Newman) provided clear objections to the lack of any references with which to combine the Griffin reference and the lack of response by the PTO to the Bowen Declaration (see Appendix) (*infra*). Despite the open incredulity demonstrated by this majority of the panel judges doubting the strength and validity of the PTO's §103 rejection, the panel submitted a CAFC Rule 36-Judgement of Affirmance Without Opinion as the final decision.

The Examiner stated that failing the ability to establish Griffin as anticipatory, it would also qualify as a violation of 35 U.S.C. §103:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Appellant responses to Examiner included a declaration that rebutted the PTO's obviousness rejection (The Bowen Declaration; 12/3/96). The Bowen Declaration asserts that prior art reference (the Griffin patent) taught only an insert mechanism to continuous feed

printers. The Bowen Declaration noted that, as opposed to continuous feed paper, standard envelopes are fed into a laser printer by rollers that engage the paper by friction. Therefore, devices designed to utilized the rotating pin feed mechanism of a continuous feed printer (set forth in the prior art) are not suitable for use in the envelope feeder of a laser printer. No other evidence was in the record on this point. During oral argument, J. Markey highlighted this lack of evidence to rebut the Bowen Declaration as a basis to criticize the PTO's obviousness rejection at oral argument.

> **J. Markey:** "...the only evidence [provided by the Board (see Appendix)] had to be common sense or general ... powers of observation. There is nothing out there ... and then you had the Bowen Declaration to come back and refute ... the Board, didn't come back."

It is improper to "simply...engage in a hindsight reconstruction of the claimed invention, using the Applicants structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teachings whereby the Applicant's combination would have been obvious." *Interconnect Planning Corp. v. Feil,* 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir (N.Y.) 1985); *see also*, *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999)(holding that the PTO use a 'clear and particular" standard that provides evidence for obviousness rejections), *abrogated by In re Gartside,* 2000 WL 156565 (Fed. Cir. 2000). This level of evidence is not on the record. The Board or Examiner has not, at any time, met this level of burden for establishing this obviousness rejection. This very point was very strongly put forward by J. Newman at oral argument:

> **Solicitor:** "... the claims are ... obvious in light of Griffin in combination with laser printer technology. ... Griffin teaches the overall concept of using an adapter and conforming the size of the adapter so that it would fit through the existing feeding arrangement of the printer."

J. Newman: "Your telling us that it would be obvious in view of combination of 'something or other', but you have neglected to cite a reference disposing what that the second component of the combination is, on which the Board is relying."

Solicitor: "...the Board here did take a look and see that laser printers had various envelope feeding arrangements... "

J. Newman: "...where does it say various envelope feeding, *I mean that is really the leap of reasoning which is unsupported by any cited references.* Is it that the envelope feeder function itself should be used to do something special, as these inventors have used it for. And there is a gap, is there not, in the reasoning that you are asking us to create or that the Board created whether as, ... common sense? I don't know ... because they [PTO Board] certainly didn't cite any references to direct someone to the use of the envelope feeder function. How do you get around that?"

J. Newman expressly points out that obviousness requires a combination of references that the Board has not supplied. The Solicitor could not get around this point. The Solicitor only offered up the following suggestion:

Solicitor: "You should look at the record and decide if there is substantial evidence to support the finding that there is a suggestion to combine the Griffin reference with the existing laser printer technology."

This closing comment by the Solicitor concerning the "substantial evidence" standard of review is incorrect for review of an obviousness rejection as a matter of law. (*supra*) The statement reflects a desire by the PTO that *Zurko* reach to include patentability questions of law such as obviousness rejections (*supra*) and mistakenly gives deference to the PTO.

III. The Federal Circuit Erred In Not Meeting The Legislative Intent of The Federal Court Improvement Act of 1982

The primary purpose for the formation of the CAFC is to eliminate the well-known and predictable variability in the several circuit courts in the review of patent cases. Congress rectified this situation resulting in a complete restructuring of several appellate court jurisdictions. Federal Courts Improvement Act of 1982, Pub. L. 97-164 (1988).

On the facts of the instant case, in which the Patent and Trademark Office (PTO) Board of Appeals decision and analysis basis was soundly criticized at the oral briefing by the Federal Circuit Panel, the resulting final CAFC Rule 36 decision in favor of the PTO begs an expressed legal analysis to conform to the legislative intent that created the court. In a situation such as this, adjudication of appeals by the Federal Circuit without providing the non-prevailing party with an analysis and interpretation of the issues or questions presented do not provide a basis for maintaining judicial consistency, uniformity, and clarity.

Historical Overview

The Senate and the House of Representatives drafted a series of similar bills in subcommittee during the 95th, 96th, and 97th congressional sessions that generated several floor debates. The final Senate draft, S. 1700 "A bill to establish a United States Court of Appeals for the Federal Circuit, to establish a United States Claims Court, and for other purposes" (sponsored by Sen. Dole) was incorporated into the final House of Representative draft, H.R. 4482 "A bill to establish a United States Court of Appeals for the Federal Circuit, to establish a United States Claims Court, and for other purposes." (sponsored by Rep. Kastenmeier). The House bill ultimately became Public Law 97-276 on 10/02/82 that provided the basis for the Federal Court Improvement Act of 1982.

The concept of forming a common jurisdiction to hear patent appeals held wide support in both congressional houses, the executive branch, and business community. The primary purpose for the congressionally-mandated formation of the CAFC is purported to stabilize the administration of patent law.

> "... stabilizing the patent law ... will ... foster investment in research and development. [...] New technology means new jobs and increased productivity ... It is no wonder then that H.R. 3806 has the support of American business..." 126 Cong. Rec. H25366 (daily ed. Sept. 15, 1980)(statement of Rep. Rodino)

> "The creation of this new court substantially improves the administration of the law in the area of patents." 126 Cong. Rec. H25364 (daily ed. Sept. 15, 1980)(statement of Rep. Kastenmeier)

The CAFC was challenged to rectify festering problems created by the regional Circuit Courts of Appeal. Of particular interest was the elimination of the well-known predictable, but diversified, decisions during patent validity assessments that resulted in forum shopping.

> "A second specific goal of the legislation is to provide increased uniformity in the patent law." 126 Cong. Rec. H25364 (daily ed. Sept. 15, 1980)(statement of Rep. Kastenmeier)

> "The Court of Appeals for the Federal Circuit will deal with appellate review, where the interpretation of the law is paramount. We are aiming for a definitive, uniform, and clear interpretation of the national law of patents." 127 Cong. Rec. S29887 (daily ed. Dec. 08, 1981)(statement of Sen. Grassley)

> "The creation of this appellate structure will eventually lead to uniformity in this very important and specialized field of law." 127 Cong. Rec. S29861 (daily ed. Dec. 08, 1981)(statement of Sen. Thurmond)

> "One major concern has been the need to achieve definitive, consistent and expeditious rulings ... One area where a confusion of diverse adjudications has been the most troublesome has been in the articulation and development of patent law at the appellate level." 127 Cong. Rec. S29858 (daily ed. Dec. 08, 1981) (statement of Sen. Dole)

This lack of uniformity generated an inability of both the legal and business professions to anticipate the intent of the judicial system in cases determining patent validity due to the lack of consistency and clarity. Importantly, there was a recognition that patent law -- because of its relationship with technology -- had a *particular* need for clarity (*i.e.* above and beyond what might be needed in other legal fields).

> "...patent law stands apart from virtually every other legal discipline both in its extreme focus on science and technology and its need for uniformity in decision-making." 127 Cong. Rec. S29861 (daily ed. Dec. 08, 1981)(statement of Sen. Leahy)

> "The present patent adjudication system is [...] a quagmire of doctrinal inconsistency and is slow and outrageously expensive for litigants whether they be small inventors or large corporations." 127 Cong. Rec. S29861 (daily ed. Dec. 08, 1981)(statement of Sen. Dole)

Opposition

The objections to CAFC formation were based primarily on the concern that, with only a single court, patent law would not benefit from the exchange of ideas between the circuits:

> "... I fear that the justice that is ultimately available to patent litigants will suffer from a lack of the diversity of opinion that has been such an integral part of our system of justice." 127 Cong. Rec. S29888 (daily ed. Dec. 08, 1981)(statement of Sen. Simpson)

The instant case demonstrates that the predictions of the CAFC opponents are surfacing. The present appeal argues that this "Affirmance Without an Opinion" decision by the CAFC does not meet the congressional intent to "clarify and unify" patent law, and is consistent with the concerns of the as to the wisdom of the creation of a specialized patent appeals court.

The above congressional record is replete with linkage of the uniformity of patent law with the necessity of judicial clarity and consistency. Legal consistency is not only relevant in maintaining *stare decisis* but is also critical to maintain within a specific case. During the appeal to the CAFC in the present case, the PTO presented an argument that the appellant had not met the statutory patentability requirements. The transcripts of the oral argument to the court below show, without question, that the CAFC clearly disagreed with the logic and facts supporting the PTO's argument and patentability decision. The CAFC comments and observations entered on the record during the oral argument, are diametrically opposed to, and inconsistent with, the final decision. Furthermore, the choice of the CAFC to decide by Rule 36 leaves the appellant without any information on which to make future patent-related decisions.

The CAFC decision in this case is without question analogous to the impact that led to the CAFC's formation. Simply put, this inconsistent and non-uniform legal process presented in an unclear

and indefinite manner is resulting in public confusion and an inability for business to plan future investments by anticipating the legal patent consequences of their decisions.

This clear contradiction between the record of the oral argument and final judgement represents the antithesis of the congressional legislative intent that necessitated CAFC formation. There is a clear congressional consensus that inconsistent patent adjudication has a significant negative impact on the economy and public welfare. Prevention of legal inconsistency requires uniformity in legal process and clarity in legal expression. Therefore, it stands to reason that non-uniformity between what the CAFC says and does, without further explanation (*i.e.*, clear expression), will have the same effect on the economy and social welfare as the pre-CAFC forum shopping problem instigated by the inconsistency between the regional federal circuit courts. As a result we urge the Court remand this case based on lack of adherence to the formative CAFC legislative intent.

Respectfully Submitted,
MEDLEN & CARROLL

Date _____ By _____

Peter G. Carroll
Attorney for Appellants

CONTENTS

TAB A: Court of Appeals for the Federal Circuit Mandate: Rule 36 Affirmance Without Opinion

TAB B: United States Patent and Trademark Office Board of Patent Appeals and Interferences: *In re Bowen* Appeal Opinion

TAB C: The Bowen Declaration

TAB D: United States Patent; Griffin - Reusable Stationary Carrier; US, 4,790,475

NOTE: Pursuant to Fed. Cir. R. 47.6, this opposition is not citable as precendent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

99-1260
(Serial No. 08/758,756)

IN RE JULIE A. BOWEN and BARBARA J. MARTY

Judgment

ON Appeal from the Patent & Trademark Office
Board of Patent Appeals and Interferences

In CASE NO(S). 08/758,756

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam: (MAYER, Chief Judge, NEWMAN and LOURIE, Circuit Judges):

AFFIRMED. See Fed. Cir. R. 36

ENTERED BY ORDER OF THE COURT

Dated: Dec. 13, 1999

S/
Jan Horably, Clerk

ISSUED AS A MANDATE: FEBRUARY 3, 2000

FILED U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT DEC 13, 1999 JAN HORBALY CLERK

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JULIE A. BOWEN and BARBARA J. MARTY

Appeal No. 98-2380
Application No. 08/758,756[1]

ON BRIEF

Before MEISTER, FRANKFORT, and PATE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

MAILED: DEC 04, 1993
PAT. & TM. OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

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[1] Application for patent filed December 3, 1996. According to appellants this application is a continuation of Application No. 08/458,993, filed June 2, 1995, now abandoned; which is a continuation of Application No. 08/223,572, filed April 6, 1994, now abandoned.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 6, 8 and 9, all of the claims remaining in the application. Claims 2, 5, 7 and 10 through 13 have been canceled.

Appellants' invention relates to an adapter used for inserting a label into a laser printer and to a method of printing a label using a laser printer having an envelope feeder. Independent claims 1 and 6 are illustrative of the subject matter on appeal and a copy of those claims is appended to this decision.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Griffin	4,790,475	Dec. 13, 1988

Claims 1, 3, 4, 6, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being obvious over Griffin.

Reference is made to the answer (Paper No. 18, mailed December 11, 1997) for the examiner's reasoning in support of the rejections to appellants' brief (Paper No. 17, filed September 2, 1997) and reply brief (Paper No. 19, filed February 12, 1998) for the arguments thereagainst.

OPINION

Having carefully reviewed and evaluated the issues raised in this appeal in light of the record before us, we have come to the conclusion, for the reasons which follow, that the examiner's rejection of the appealed claims under 35 U.S.C. § 102 is not well founded and will not be sustained. However, we are in agreement with the examiner's conclusion of obviousness under 35 U.S.C. § 103 with respect to claims 1, 3, 4, 6, 8 and 9, and thus that rejection will be sustained. Our reasoning with regard to these determinations follows.

Considering first the examiner's rejection of claims 1, 3, 4, 6, 8 and 9 under 35 U.S.C. § 102(b) based on Griffin. We note that claim 1 on appeal recites that the apparatus for inserting a label into a laser printer consists of a four-sided adapter "of a size of an envelope accepted by an envelope feeder of a laser printer" and sets forth that the adapter further includes a window for exposing the label within the adapter and that the adapter carries the label through a laser printer while the printer prints on the label. Method claim 6 specifies, in step a), "providing i) a laser printer having an envelope feeder," an adapter of the type defined in claim 1 and a label. Since Griffin makes no mention whatsoever of a laser printer or an envelope feeder associated with such a printer, we are of the

opinion that Griffin does not and cannot anticipate the apparatus and method as defined in the present application. Accordingly, the examiner's rejection of claims 1, 3, 4, 6, 8 and 9 under 35 U.S.C. § 102(b) based on Griffin will not be sustained.

With regard to the examiner's alternative rejection of claims 1, 3, 4, 6, 8 and 9 under 35 U.S.C. § 103 over Griffin, we note that the reference patent discloses an apparatus for inserting "conventional stationary such as notes, memos, letters or envelopes" (col. 2, lines 46-47) into a printer, wherein the apparatus consists of an adapter sealed on three sides and having a window for exposing the inserted note, memo or envelope within the adapter and carrying the note, memo or envelope through the printer while the printer prints on the note, memo or envelope. Griffin expressly indicates at numerous places throughout the specification that the adapter is to be used in conjunction with "computer printers, word processing printers, and the like" (see, e.g., col. 1, lines 7-8). In addition, Griffin refers to "other high speed printers" (col. 1, line 48) and "a high speed computer printer" (col. 2, line 18). On page 7 of their brief, appellants characterize Griffin as teaching "an apparatus suitable for use in a tractor feed printer for printing on labels." As recognized by appellants and as conceded by the examiner, what Griffin (filed July 12, 1982) lacks is any mention of laser printers.

Like the examiner, it is our opinion that one of ordinary skill in the art at the time of appellants' invention (first filed April 6, 1994) would have been knowledgeable about laser printers and various envelope feeding arrangements therefor, and that such knowledge in combination with the teachings and suggestions found in Griffin would have made the presently claimed subject matter (apparatus and method) obvious to one of ordinary skill in the art. Given the known advantages of a laser printer over other high speed computer printers and the teachings/suggestions concerning the adapter of Griffin with regard to printing items such as notes, memos, labels, etc, in a high speed computer printer, it is our position that it would have been obvious to one of ordinary skill in the art at the time of appellants, invention to use the adapter of Griffin in a laser printer, particularly wherein the feed to the laser printer is in the form of a tractor feed mechanism like that discussed or referred to in Griffin.

Appellants, argument in the brief, reply brief and in the declaration filed February 12, 1998, that Griffin's adapter is not of a size suitable for insertion into the envelope feeder of a laser printer, because it is not dimensioned so that it can be inserted into a "standard" laser printer, or, more precisely, into a "standard" laser printer envelope feeder which accepts up

to eight and one half inch wide paper, is not persuasive. As pointed out by the examiner (answer, page 5) envelopes come in a wide variety of different sizes, e.g., from small party invitation envelopes or "Thank You" card envelopes, up to large commercial size envelopes, thus any size limitation provided in the claims on appeal by the recitation that the adapter is "of a size of an envelope accepted by an envelope feeder of a laser printer," in fact covers a broad range of sizes and not just a "standard" size of, for example, eight and one half inches as appellants seem to believe.

While the declaration attached to the reply brief (Paper No. 19) urges that laser printer envelope feeders are dimensioned to accept "standard size envelopes" (paragraph 9), we are given no guidance in appellants, specification, the claims on appeal, or otherwise as to exactly what a "standard" size envelope might be for a laser printer envelope feeder. Moreover, while the declaration (paragraph 10) urges that "standard envelopes are fed into the laser printer by rollers that engage the paper by friction," as opposed to a continuous feed arrangement like that seen in Griffin, we find nothing in the claims on appeal which limits the "envelope feeder" (e.g., claim 6) to one where the envelope is necessarily contacted by rollers that engage the paper by friction, instead of one involving a pin feed mechanism

as described in Griffin. Contrary to appellants, arguments, the claims on appeal simply do not contain any particular limitation as to the size of the adapter, the size of "an envelope accepted by an envelope feeder of a laser printer," or as to the type of envelope feeder that might be associated with a given laser printer. While an envelope feeder that is associated with a typical home computer laser printer would accept one range of envelope sizes and have a given type of roller feed, a commercial establishment typically would have a laser printer which accepts a much wider range of envelope sizes (e.g., up to poster size) and have a pin-type tractor feed mechanism that would better meet the needs of a commercial establishment.

Based on the foregoing, we will sustain the examiner's rejection of claims 1, 3, 4, 6, 8 and 9 under 35 U.S.C. § 103.

In summary:

The examiner's rejection of claims 1, 3, 4, 6, 8 and 9 under 35 U.S.C. § 102(b) over Griffin is reversed.

The examiner's rejection of claims 1, 3, 4, 6, 8 and 9 under 35 U.S.C. § 103 over Griffin is affirmed.

Accordingly since at least one rejection of all of the claims on appeal has been sustained, the decision of the examiner is affirmed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

S/_____
JAMES M. MEISTER)
Administrative Patent Judge)

) BOARD OF PATENT
S/_____) APPEALS
CHARLES E. FRANKFORT) AND
Administrative Patent Judge) INTERFERENCES

)
S/_____)
WILLIAM F. PATE)
Administrative Patent Judge)

CEF/sld

Appendix

1. An apparatus for inserting a label into a laser printer consisting of a four-sided adapter of a size of an envelope accepted by an envelope feeder of a laser printer, being sealed on three sides and having a window for exposing the label within the adapter and for carrying the label through a laser printer while the printer prints on the label.

6. A method for printing a label comprising the steps of:

a. providing i) a laser printer having an envelope feeder; ii) an adapter of a size of an envelope accepted by said envelope feeder of said laser printer, said adaptor being sealed on three sides and having a window; and iii) a label;

b. inserting said label into said adapter such that said label is exposed through said window;

c. inserting the adapter carrying the label into said envelope feeder of said laser printer; and

d. instructing said laser printer to print on said label.

Peter G. Carroll
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Suite 2200
San Francisco, CA 94104

PATENT
Attorney Docket No. **BOWEN-02573**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Julie Anne Bowen *et al.*
Serial No.: 08/758,756 Group No.:3307
Filed: 12/03/96 Examiner:A. Nguyen
Entitled: **Method And Apparatus For Printing Labels On A Printer**

DECLARATION

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)(1)(i)(A)
I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Dated: February 9, 1998 By: s/
Linda P. Collins

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir or Madam:

I, Julie A. Bowen, state that:

1. I am one of the inventors of the invention as described in the parent application of the present case now on appeal, *i.e.* United States Patent Application Serial No. 08/458,993 and titled "METHOD AND APPARATUS FOR PRINTING LABELS ON A PRINTER."

2. I have reviewed the Final Office Action dated 08/06/96.

3. I have reviewed U.S. Patent No. 4,790,475 to Griffin ("the Griffin patent").

4. The device in the Griffin patent is designed for use in a continuous feed printer.

5. The truth of the statement in paragraph 4 is supported by the fact that laser printers were not widely available at the time of the filing of the Griffin patent (July 12, 1992). Evidence of this comes from the Griffin document itself (*i.e.*, Griffin makes absolutely no mention of laser printers and envelope feeders). The statement made at column 1 lines 56-66 of the Griffin patent that reveals that Griffin (in his broadest notion) is aware of only the continuous feed type printers:

> According to the broad aspect of the invention there is provided a continuous stationary carrier ... provided with a plurality of feed apertures along the right and left margins thereof...

6. Continuous feed printers utilize paper that is generally wider than the standard eight and one half inch width

of standard stationary paper.

7. The increased width of continuous feed paper allows for holes placed along both sides of its length that engage with rotating pins positioned on the continuous feed printer that feed the paper into the printer.

8. In order to be fed into continuous feed printers, odd dimensioned paper, such as labels, must either have holes to engage the rotating pins or be placed in a device such as described in the Griffin patent.

9. Laser printer envelope feeders are dimensioned to accept standard size envelopes.

10. As opposed to continuous feed paper, standard envelopes are fed into the laser printer by rollers that engage the paper by friction.

11. Therefore, devices designed to utilized the rotating pin feed mechanism of a continuous feed printer are not suitable for use in the envelope feeder of a laser printer.

12. I recognized the need for a device that would permit the feeding of odd dimensioned paper, such as labels,

into a standard laser printer envelope feeder.

13. In response to this problem, I designed an apparatus for printing labels on a standard laser printer through its envelope feeder.

14. My choice of size and material for my apparatus was unrecognized in the art and represents a departure from the solutions devised for continuous feed printers.

15. For these and other reasons, my invention should be considered nonobvious.

The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Dated: February 9, 1998

/s
Julie A. Bowen

United States Patent [19]

Griffin

[11] **Patent Number: 4,790,475**

[45] **Date of Patent: Dec. 13, 1988**

[54] **REUSABLE STATIONERY CARRIER**

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[21] Appl. No.: **397,358**

[22] Filed: **Jul. 12, 1982**

[51] Int. Cl.[4] B65D 27/10

[52] U.S. Cl. ..... 229/69; 101/407 R; 206/820; 400/522

[58] Field of Search ..... 229/73, 69, 72; 282/11.5 A; 206/820; 40/159, 160, 154, 124.2, 537, 405; 101/407 R, 269; 400/522, 525, 531

[56] **References Cited**

U.S. PATENT DOCUMENTS

2,034,730	3/1936	Palley	400/522
3,312,385	4/1967	Amort	229/73
3,820,447	6/1974	Gendron et al.	229/73
4,077,323	3/1978	Liuzzo	101/407-R
4,214,388	7/1980	Dickey	40/159
4,239,114	12/1980	Denay	229/69

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[57] **ABSTRACT**

The continuous stationery carrier which is adapted to be fed through computer printers, word processing printers, and the like so as to permit the stationery carried therein to be printed upon comprises a plurality of polyethylene backing sheets sequentially joined together along perforated fold lines and equipped with a plurality of feed apertures along the right and left margins thereof. Each backing sheet has a polyethylene cover sheet joined thereto in pocket forming relationship therewith so as to be capable of retaining a piece of stationery. Each cover sheet is provided with at least one aperture therein through which the stationery may be printed upon. The shape and the size of the cover sheets and the apertures therein may be selected to suit a particular application.

10 Claims, 1 Drawing Sheet

